

**REMARKS**

Applicant has carefully reviewed the Final Office Action mailed April 10, 2006 and offers the following remarks.

Applicant appreciates the telephonic interview conducted between Examiner Avi Gold and Applicant's representative John R. Witcher on July 10, 2006. In the Interview, Applicant argued that there was no motivation to combine U.S. Patent No. 6,611,874 to Denecheau, the admitted prior art, and U.S. Patent No. 6,421,734 to Nessett. In particular, Applicant pointed out that the Patent Office had failed to provide actual evidence to support the motivation to combine (see below) and that the Patent Office's statement that the combination uses knowledge generally available to one of ordinary skill in the art is exactly the sort of alleged evidence that is insufficient under the MPEP and the case law. The Applicant also reiterated its argument that the combination of references would render Denecheau unsuitable for its intended purpose. Finally, Applicant argued that Nessett does not teach the compute plane of the claims. Applicant and the Examiner discussed the meaning of the term compute plane and where it was discussed in the specification and whether a compute plane as claimed was taught by Nessett. The Examiner indicated that he understood Applicant's position, but that he did not necessarily agree with it and would have to discuss the matter further with the Primary Examiner. No agreement was reached on the discussed issues, but Applicant appreciates the fact that the Examiner was willing to further consider Applicant's arguments. In light of the indication from the Examiner that he would review a formal response setting forth in detail the above arguments with the Primary Examiner, Applicant hereby formally responds to the outstanding Final Office Action as follows.

Claims 1-50 were rejected on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claims 1-37 of U.S. Patent No. 6,970,943 to Subramanian et al. (hereinafter "Subramanian"). Depending on the language of any claims in the current application that are deemed allowable, Applicant will address the issue at that time by considering the filing of a terminal disclaimer. Applicant also reserves the right to traverse the Examiner's rejection that the claims of the present invention are not patentably distinct from the claims of U.S. Patent No. 6,970,943 depending on the form of the claims as allowed.

Claims 1-47 and 50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,611,874 to Denecheau et al. (hereinafter "Denecheau") in view of Applicant's

Admitted Prior Art (hereinafter "AAPA") and further in view of U.S. Patent No. 6,421,734 to Nessett et al. (hereinafter "Nessett"). Applicant respectfully traverses. To establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is taught or suggested in the combination of references. For the Patent Office to combine references in an obviousness rejection, the Patent Office must prove there is a suggestion to combine the references. For the Patent Office to prove that there is a suggestion to combine the references, the Patent Office must do two things. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). MPEP § 2143.03. If the Patent Office cannot establish obviousness, the claims are allowable.

Applicant, in its previous response, traversed the motivation to combine the references by pointing out that the Patent Office's asserted motivation to combine Denecheau with AAPA and Nessett lacks the evidence required by the Federal Circuit in *In re Dembiczak* (Response mailed January 19, 2006, p. 2). The Patent Office responds with the standard cite to *In re Fine* and *In re Jones* for the proposition that obviousness can only be established by combining the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art (Final Office Action mailed April 10, 2006, p. 13, paragraph 6). The Patent Office ignores the holding of the Federal Circuit in *Dembiczak*, which specifically acknowledged *Fine*, but emphasized the requirement for actual evidence in proving the motivation to combine the references, stating that "[t]he range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). In the Final Office Action, the Patent Office states the combination of Denecheau and AAPA, and the combination of Denecheau, AAPA, Nessett, and Chiu use knowledge generally available to one of ordinary skill in the art. This is exactly the kind of conclusory statement, with no actual evidence to support it, which is not the necessary evidence required by the Federal Circuit to support a stated motivation to combine. In addition, the courts have held that a statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" is not sufficient to establish

a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993); see also *In re Kotzab*, 217 F.3d 1365, 1371, (Fed. Cir. 2000); MPEP §2143.01(IV). To this extent, the motivation advanced by the Patent Office lacks the required evidence to support it and therefore is not sufficient. Since the motivation to combine is improper, the proposed combination is improper. Since the combination is improper, the rejection is improper, and the claims are allowable. Applicant maintains its request that the § 103 rejection of the claims be withdrawn on this basis.

In paragraph 7 of the Response to Arguments section of the Final Office Action, the Patent Office argues that one cannot show nonobviousness by attacking references individually where rejections are based on combinations and states that this applies to the arguments that Denecheau does not teach application level support which is already admitted to in the action (Final Office Action mailed April 10, 2006, p. 13). Perhaps the Examiner has misunderstood the Applicant's previous argument. Applicant mentioned that Denecheau does not teach application level processing in the node as part of its argument that the combination of Denecheau, AAPA, and Nessett was improper because the combination renders Denecheau unsuitable for its intended purpose (Response mailed January 19, 2006, pp. 2-3). The Patent Office has not responded at all to this argument in the current Final Office Action. Applicant reiterates this argument. As noted in the previous response of January 19, 2006, making a reference unsuitable for its intended purpose is evidence of non-obviousness. MPEP § 2143.01. Thus, the combination that the Patent Office is proposing is not obvious, and the claims are allowable.

Applicant had also previously argued that, even if the combination is proper, the Patent Office has not established obviousness because as admitted by the Patent Office, Denecheau and AAPA do not teach the compute plane in the routing node, and Nessett contains no teaching that the decompression and compression resources 112, 113 of Nessett are within a compute plane as recited in the claims. Applicant refers to, and maintains, the full argument set forth in its previous response on this point (Response mailed January 19, 2006, p. 3). The Patent Office's only rebuttal in the Final Office Action is that Nessett discloses an intermediate device which applies compression and/or encryption, which are the same functions as the claimed compute plane as shown in Applicant's specification (Final Office Action mailed April 10, 2006, paragraph 7, pp. 13-14).

First of all, even assuming that Nessett discloses an intermediate device which performs similar functions as the claimed compute plane, Nessett, alone or in combination with Denecheau and AAPA, still does not teach configuring the routing nodes to include a control plane, a compute plane, and a forward plane, and selecting at least one routing node capable of providing the processing resources required to provide the application level support for the select traffic in the compute plane of the least one routing node, as required by the claims. Second, the functions mentioned by the Examiner are not even part of the claims. Even if they were part of the claims, a prior art device that performs all the functions recited in the claim still does not render the claims unpatentable if there is any structural difference. MPEP §2114. Just because the intermediate device may perform some of the same functions as the claimed compute plane does not make it the claimed compute plane. In the present case, in order to teach each and every element of the claim, there must be some teaching or suggestion that the application level functions are provided on a compute plane. To date, the Patent Office has provided no explanation or teaching for why the decompression and compression functions of Nessett would be moved to a compute plane per the claims. Thus, the combination does not teach or suggest the elements as arranged in the claims, and the Patent Office has therefore not established *prima facie* obviousness. Since the Patent Office has not established obviousness, the claims are allowable.

For the above reasons, Applicant requests withdrawal of the § 103 rejection of claims 1-47 and 50.

Claims 48 and 49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Denecheau, AAPA, and Nessett and further in view of U.S. Patent No. 6,701,363 to Chiu et al. (hereinafter "Chiu"). With respect to these claims, Applicant maintains its argument from the previous response that the Patent Office has not provided the required evidence to support the stated motivation to combine Chiu with the other references, and that the addition of Chiu does not cure the deficiencies of the combination of Denecheau, AAPA, and Nessett, which is also improper and does not teach all the elements of the independent claims (Response mailed January 19, 2006, p. 4). Thus, claims 48 and 49 are allowable.

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant's representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

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